

PATENT COOPERATION TREATY

1893.03(a)

whichever expires later. The time period is subject to the provisions of 37 CFR 1.136(a).

1893.01(e) Oath/Declaration [R-1]

Applicants entering the national stage in the U.S. are required to file an oath or declaration of the inventor in accordance with 37 CFR 1.63. If the basic national fee has been paid by the expiration of 20 or 30 months from the priority date as appropriate, but the required oath or declaration has not been filed, the Office will send applicant a notice of Missing Requirements setting a time period to correct any missing or defective requirements. The time period is 21 months or 31 months from the priority date, as appropriate, or 1 month from the date of the notice, whichever expires later. The time period is subject to the provisions of 37 CFR 1.136(a). The oath or declaration must comply with the requirements of 35 U.S.C. 115 and with the regulations prescribed for oaths and declarations, see especially 37 CFR 1.63.

If an inventor refuses to execute the oath or declaration or is unavailable, applicant must file an oath or declaration and a petition in accordance with 37 CFR 1.47. Similarly, where an inventor is deceased or legally incapacitated, an oath or declaration in accordance with the provisions of 37 CFR 1.42 or 1.43 must be provided. To avoid abandonment the oath or declaration and petition (under 37 CFR 1.42, 1.43 and/or 1.47, as appropriate) must be filed either before expiration of 20 or 30 months from the priority date, as appropriate, or, where a notification of deficiency of the oath/declaration has been mailed, within the time for response to that notification.

If applicant has filed an oath or declaration and petition under 37 CFR 1.42, but has not provided proof of authority of the legal representative as required by 37 CFR 1.44, the application papers will be provisionally accepted for entry into the national stage and forwarded for further processing and examination on the merits. However, if sufficient proof of authority of the person(s) signing as legal representative of the deceased inventor is not provided before mailing of the notice of allowance, the application should be forwarded to the "PCT Legal Affairs Branch". If proof of authority is not filed, the application will be held not to have entered the national stage for failure to provide an oath or declaration as required by 35 U.S.C. 371(c)(4) and will be held abandoned in accordance with 37 CFR 1.494(g) or 1.495(h). Under such circumstances the date of abandonment will be the date of expiration of 20 months from the priority

date or, where a notification of deficiency of the oath/declaration has been mailed, the date of expiration of the time for response to that notification or as extended by any extension fee timely paid under 37 CFR 1.136(a).

1893.02 Abandonment

If the requirements of 35 U.S.C. 371(c) are not complied with by the time period set in 37 CFR 1.494(b) and (c) or 37 CFR 1.495(b) and (c), as appropriate, the application is considered to be abandoned, see 37 CFR 1.494(g) and 37 CFR 1.495(h).

Examiners and applicants should be aware that sometimes papers filed for the national stage are deficient and abandonment results. For example, if the fee submitted does not include at least the amount of the basic national fee that is due, the application becomes abandoned.

Applicant may file a petition to revive an abandoned application in accordance with the provisions of 37 CFR 1.137. See MPEP § 711.03(c).

1893.03 Prosecution of U.S. National Stage Applications Before the Examiner

An international application which enters the national stage will be forwarded to the appropriate examining group for examination in turn based on the 35 U.S.C. 102(e) date of the application. Once the application is forwarded to the examiner, prosecution proceeds in the same manner as for a domestic application with the exceptions that (1) the international filing date is the date to keep in mind when searching the prior art and (2) unity of invention proceeds as under 37 CFR 1.475.

1893.03(a) How To Identify That an Application Is a U.S. National Stage Application [R-1]

Applicant's initially deposited application must indicate that treatment as a national stage application (filed under 35 U.S.C. 371) is requested (see 37 CFR 1.494(f) and 37 CFR 1.495(g)). Otherwise, the application will be treated as an application filed under 35 U.S.C. 111(a).

That is, if applicant wishes the application to be filed under 35 U.S.C. 111(a), applicant's originally filed application papers need indicate simply that the papers are for a new U.S. patent application. If, however, applicant is filing papers for entry into the national stage of a

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PCT application, applicant must so state. 37 CFR 1.494(f) and 1.495(g) require that applicant's application papers must be clearly identified as a submission to enter the national stage under 35 U.S.C. 371; otherwise the submission will be considered as being made under 35 U.S.C. 111. Examination of the originally filed application papers occurs in either the Application Processing Division or in the Designated/Elected Office (DO/EO) section of the PCT International Division where it is determined whether applicant has asked that the papers be treated as a national stage filing under 35 U.S.C. 371. If the application is accepted for entry into the national stage, the DO/EO will fill out and mail Form PCT/DO/EO/903 indicating acceptance of the application as a national stage filing under 35 U.S.C. 371 and will stamp the face of the file with an indication that the application is filed under 35 U.S.C. 371. Accordingly, the three key indicators which reflect that an application is filed under 35 U.S.C. 371 are (1) the file face indication of a filing under 35 U.S.C. 371, (2) the Form PCT/DO/EO/903 indicating acceptance of the application as a national stage filing under 35 U.S.C. 371, and (3) applicant's statement (or the equivalent) in the originally filed application papers that the application is a national stage filing under 35 U.S.C. 371. Applicants who use transmittal Form PCT/DO/EO/1390 will satisfy this requirement since the form includes an indication that the application is a national stage filing under 35 U.S.C. 371.

Initially, the examiner should inspect the face of the file jacket for an indication that it is filed under 35 U.S.C. 371 and should also check the application papers for the presence of Form PCT/DO/EO/903. If neither of these indications are present the application may, in the absence of evidence to the contrary (there is an

indication in the originally filed application papers that processing as a national stage is desired), be treated as a filing under 35 U.S.C. 111>(a)<. Thus, if both indications are present, the application should be treated as a filing under 35 U.S.C. 371. If the face of the file jacket does not indicate a filing under 35 U.S.C. 371, but a properly completed Form PCT/DO/EO/903 is in the file, the examiner should complete the face of the file by adding "filed under 35 U.S.C. 371" in the upper left margin thereof. The examiner should initial and date this change. If the file wrapper does not include a properly completed Form PCT/DO/EO/903 but the face of the file indicates a filing under 35 U.S.C. 371, the application should be returned to the DO/EO Section of the International Division for certification that the application has been accepted for the national stage.

In accordance with the notice at 1077 OG 13 (14 April 1987), if the applicant files a U.S. national application and clearly identifies in the accompanying oath or declaration the specification to which it is directed by referring to a particular international application by PCT Serial Number and International Filing Date and that he or she is executing the declaration as, and seeking a U.S. Patent as, the inventor of the invention described in the identified international application, then the application will be accepted as filed under 35 U.S.C. 371. Merely claiming priority of an international (PCT) application in an oath or declaration will not serve to indicate a filing under 35 U.S.C. 371. Also, if there are any conflicting instructions as to whether the filing is under 35 U.S.C. 111>(a)< or 35 U.S.C. 371, the application will be accepted as filed under 35 U.S.C. 111>(a)<.